

### **REMARKS**

In response to the Office Action mailed June 14, 2005, Applicant respectfully requests reconsideration. Claims 1-27 were previously pending in this application. Claims 28-29 have been added. No claims have been amended or canceled. As a result, claims 1-29 are pending for examination, with claims 1, 9 and 16 being independent.

#### **Telephone Interview with Examiner**

Applicant's representatives wish to thank Examiner Le for the courtesies extended in granting and conducting a telephone interview on November 1, 2005. The substance of the interview is summarized herein.

During the interview, Applicant's representatives provided a brief overview of one embodiment of the invention, a self-adhesive electronic circuit having a double-faced adhesive with a chip disposed in an opening therein. The self-adhesive electronic circuit may, for example, be adhered to an item for identification.

Applicant's representatives also pointed out fundamental differences between the claims and the RFID tag disclosed by U.S. Patent No. 5,708,419 to Isaacson et al. ("Isaacson"), which is the primary reference relied upon by the Examiner in rejecting the independent claims under 35 U.S.C. §103. Specifically, the tag of Isaacson is not self-adhesive, but rather is adapted for human handling, much like a credit card, and as such includes a protective (and non-adhesive) polymer housing (col. 10, lines 13-14). In addition, Applicant's representatives pointed out that the structure disclosed by Isaacson includes a chip which protrudes past an outer surface of an adhesive located underneath the protective housing, such that this outer surface would be unsuitable as an outward adhesive surface of a self-adhesive electronic circuit.

Applicant's representatives then requested that the Examiner clarify the rejection of independent claims 1 and 16 over a combination of Isaacson and U.S. Patent No. 5,905,429 to Hornstein et al. ("Hornstein"). In particular, Applicant's representatives requested that the Examiner explain what structure is believed to result from a combination of Isaacson and Hornstein. Hornstein, which discloses an audio label having a outer paper layer that may be peeled off to expose an adhesive and allow the label to be affixed to an item (col. 6, lines 56-58), is relied upon to

show a protective cover that is removable to expose a double-faced adhesive as an outward adhesive layer.

Applicant's representatives pointed out that a skilled artisan following the combined teachings of the references would not be led to a structure wherein the protective housing of Isaacson is somehow made peelable to expose an adhesive underneath. Rather, at best, one might be motivated to provide the outward adhesive layer and the paper layer of Hornstein atop the protective housing of Isaacson, such that an adhesive would sit between the housing and paper and could be exposed by peeling the paper away if desired to attach the card to another surface.

The Examiner evidenced an appreciation for this argument, and asked that Applicants reduce it to writing for her consideration.

Rejections under 35 U.S.C. §103(a)

Claims 1-27 are rejected under 35 U.S.C. §103(a). More specifically, claims 1-3, 6-7, 16-18 and 21-23 are rejected as being unpatentable over Isaacson in view of Hornstein, and claims 9-11 and 14-15 are rejected as being unpatentable over Isaacson in view of Hornstein and U.S. Patent No. 6,089,461 to Murohara ("Murohara"). It is respectfully asserted that the rejections under 35 U.S.C. §103(a) are improper because the Office Action fails to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, the Office Action must explain the structure one of skill in the art would purportedly have been led to based on the combined teachings of the cited references. MPEP §2142. That is, the Office Action must explain "the proposed modification of the applied references necessary to arrive at the claimed subject matter." MPEP §706.02(j). It is respectfully asserted that the Office Action fails to meet this burden, as no indication is given of the structure that would allegedly result from the combination.

A *prima facie* case of obviousness is also not set forth because one skilled in the art would not have been motivated to combine the references in a manner which meets the claim limitations. In paragraph 3, the Office Action alleges that one of skill in the art would have been motivated to modify the structure disclosed by Isaacson according to Hornstein to provide a tag which can be affixed or secured to a product during handling or transport. As discussed above, even assuming *arguendo* that one skilled in the art would have been so motivated (which Applicant does not

concede), Applicants respectfully assert that the skilled person would be led to simply attach an adhesive to the outer surface of the tag of Isaacson (i.e., housing 92) and cover it with the removable paper layer of Hornstein. Modifying the tag of Isaacson in this manner would result in a structure which fails to meet the limitations of each of the independent claims. Specifically, because the adhesive would reside on the outer surface of the housing, the structure would not include a double-faced adhesive which forms an outward adhesive surface and which also has an opening in which a chip is at least partially arranged. As shown in FIGS. 8 and 9 of Isaacson, chip 14 resides below the housing, and thus can not reside in an opening formed in an adhesive attached to the outer surface of the housing.

Applicant respectfully asserts that one skilled in the art would not have been motivated by Hornstein to modify the tag of Isaacson by somehow making the housing 92 of Isaacson peelable to expose an underlying adhesive as an outward adhesive surface. Doing so would essentially destroy the Isaacson tag and make it unsatisfactory for its intended purpose, as Isaacson explicitly states that the tag is designed for human handling (col. 10, line 10) and that the housing forms a protective layer for underlying components (Abstract). As a result, one skilled in the art would not have been motivated to combine the teachings of the references in this manner.

For the reasons given above, the Office Action fails to set forth a *prima facie* case of obviousness. Accordingly, the Applicant respectfully asserts that the rejection of claims 1-27 under 35 U.S.C. §103(a) should be withdrawn.

#### New Claims

New claims 28 and 29, which depend from claims 1 and 16, respectively, are provided to further define Applicant's contribution to the art.

Each of claims 28 and 29 includes a limitation requiring that the chip not protrude past the second surface of the double-faced adhesive, which is the surface which is covered by the protective cover. This feature is neither disclosed nor suggested by Isaacson or Hornstein. For example, as discussed above, Isaacson discloses a structure wherein the chip protrudes past the outer surface of a

double-faced adhesive into a recess formed in the housing. As such, Applicant respectfully asserts that claims 28 and 29 are allowable over the prior art of record for this additional reason.

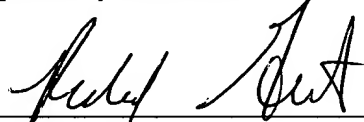
**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the application in condition for allowance.

A request for a two month extension of time is requested, Applicant hereby requests the necessary extension of time. This response, including the two month extension fee is covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: November 14, 2005

Respectfully submitted,

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